



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/895,493	07/16/1997	MAKOTO SAITO	58800.919C	1079

22804 7590 07/30/2002

THE HECKER LAW GROUP
1925 CENTURY PARK EAST
SUITE 2300
LOS ANGELES, CA 90067

EXAMINER

SEAL, JAMES

ART UNIT	PAPER NUMBER
----------	--------------

2131

DATE MAILED: 07/30/2002

40

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/895,493

Applicant(s)

SAITO, MAKOTO

Examiner

James Seal

Art Unit

2131

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) See Continuation Sheet is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Continuation of Disposition of Claims: Claims pending in the application are 95,97,99,101,103-105,107,109-111,113,115,117,119-121,123,125-127,129,131,133,135-137,139,141,142 and 148-181.

Continuation of Disposition of Claims: Claims rejected are 95,97,99,101,103-105,107,109-111,113,115,117,119-121,123,125-127,129,131,133,135-137,139,141,142 and 148-181.

DETAILED ACTION

1. The request filed on 11 February 2002 for Continued Examination (RCE) under 35 CFR 132 based on Parent Application No. 08895493 is accepted and a RCE has been established. An action on the RCE follows.
2. Claims 96, 98, 100, 102, 106, 108, 112, 114, 116, 118, 122, 124, 128, 130, 132, 134, 138, and 140 are acknowledged as having been withdrawn from consideration as being drawn to a non-elected species.
3. Claims 143-147 have been cancelled without prejudice.
4. Amended claims 95 and 111, and 127 have been entered.
5. New claims 153-181 have been entered
6. Claims 95, 97, 99, 101, 103-105, 107, 109-111, 113, 115, 117, 119-121, 123, 125-127, 129, 131, 133, 135-137, 139, 141-142, and 148-181 are pending.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 95, 97, 99, 101, 103, 104, 111, 113, 115, 119, 120, 127, 129, 131, 133, 135, and 136, 148-152 rejected under 35 U.S.C. 103(a) as being unpatentable over Dolphin (US 5457746), and further in view of Atalla (US 4588991).

8. As per amended claim 95, the limitation of controlling copyrighted digital data (i.e. controlling the distribution and use of digital data, including copyrighted material, see, e.g., Dolphin Column 9, lines 4-7 and Column 2, lines 30-32) is disclosed by Dolphin by supplying encrypted data to the user (Column 4, lines 16-18, lines 31-32, lines 44-46, and element 22, figure 2) in response to a request by the user (element 11, figure 2) supplying a utilization permit key (Column 5, lines 54-67; lines 1-10, in Dolphin, discloses a key being used to limit the number of viewings of a file for such activities as try-before-you-buy software [or database, etc.], that is, the function of the key is to permit certain types of file operations under a given set of circumstances) including a decryption (crypt) key from the key control center (Dolphin's PCMCIA, Column 4, lines 52-54. Column 5, lines 4-6) the utilization permit key permit key permitting at least one of displaying editing storing, copying and transferring (Dolphin Column 5, line 54-67; Column 6, lines 1-10 discloses using the permit key display such files number of times a file may be viewed or for limiting copying or printing), and decrypting encrypted data to decrypted data using the crypt key (Column 4, lines 46-48) and performing at least one of the functions of display, editing, storing, copying and transferring permitted by the utilization permit key (again Dolphin permit key, allows display in a trial period, but because Dolphin allows for video, image, photographs, databases, sound, software [Column 5, lines 17-18], it would also make sense to allow for other file functions to be under the permit key, for example, editing, copying and transferring of input or output data in the case of trail period software, for example). Atalla teaches that for complete security of files, that not only display function but also editing (alteration), copying

(duplication), substitution, etc. must be controlled in order to prevent security compromise of data files. Claim 95 is rejected.

9. As per claim 97, the further limitation of providing a control program from said database(see e.g., elements 70D and 70E, figure 10) to control file operations is disclosed by Dolphin (publisher 21 of figure 1). Claim 97 is rejected.

10. As per claim 99, the further limitation of copyright control program using copyright information (see e.g., Column 121, line 48 to Column 13, line 48; see especially Column 13, lines 45-47, explaining the counter updating the encryption information anticipating copyright information because it updates and enables access to new copyrighted data—of the new data is provided as part of the CD-ROM). Claim 99 is rejected.

11. As per claim 101, the limitation of providing at least one of a copyright control program, copyright information and copyright control message is disclosed by Dolphin (see e.g., figure 10). "Claim 101 is rejected.

12. As per claim 103, the limitation entering the copyright information into the data being sent is disclosed by Dolphin (see e.g., Column 13, lines 45-47). Claim 103 is rejected.

13. As per claim 104, the limitation wherein "the copyright information is entered as a computer virus" is interpreted in its broadest sense in a specific case of digital software and as such falls into Dolphin control and management of data. Claim 104 is rejected.

14. As per claims 127, 129, 131, 133, 135, and 136, the limitations of these claims are directed to the functions of the publisher in an exchange with the user recited in

Art Unit: 2131

claims 95, 97, 99, 101, 103, and 104 and are rejected in view of the same prior art of record.

15. As per claims 111, Dolphin is silent on the additional limitation of reencrypting the data after use by the user. Atalla allows the user access to secure data files (encrypted) and then reencrypts them after the user is completed with them. Further Atalla also keeps a historic record of access with regards to process and transfer (Column 1, lines 24-44). One of ordinary skill in the art would have recognized that the storage of controlled digital information in an uncontrolled manner would give rise to the possibility of copyright violation and thus denying the author of proper apportionment of royalties and would have thus been motivated to modify the teachings of Dolphin with those of Atalla to prevent this.

16. Claims 113, 115, 119, and 120 parallel the limitations of 101, 103, and 104 and are rejected in view of the same prior art of record.

17. As per claims 148-152, Dolphin teaches the use of the permit key in at least the operations of displaying a copyrighted file (5:54-6:10 and 7, lines 14-20). Atalla extends such file manipulation to copying (duplication), editing (alteration). Claims 148-152 are rejected.

18. Rejection of claims 105, 107, 109, 110, 121, 123, 125, 126, 137, 139, 141, 142, 153, 154, 155, 156, 157-168 and 169-181 under 35 U.S.C. 103 as being unpatentable over Dolphin and Atalla as applied above and further in View of Daniele (5,444,779).

19. As per claim 105, the limitations of adding an edit and transfer history to copyrighted information, Dolphin discloses the importance of maintaining an audit trail

as well time-stamping the controlled digital information, that is, a usage history for each document processed by the user (see e.g., Column 7, lines 14-20) and further recognizes the need to protect copyrighted materials from piracy (see e.g., Column 9, 4-7). Dolphin is silent on the details on what information should be included in the audit trail in particular with regards to the protection of documents from copyright infringements. Daniele supplies details for a copyright management program including collection of copyright information such as author publisher ISBN numbers, record of usage, copyright notification and menu driven function selection (see e.g. Figure 2, claims, 8:56-9:26). One of ordinary skill in the art wishing to implement the teachings of Dolphin would have looked to Daniele to provide the details on auditing procedures for copyrighted digital material. In particular Daniele (8:56-9:26) teaches modifying the copyright control glyph to indicate the status and history of the document for auditing and tracking of royalty information and accounting. In light of this teaching one of ordinary skill in the art would have been motivated to include similar auditing information in a copyright control system to allow for proper apportionment of royalties. Claim 105 is rejected.

20. Claims 107, 109, and 110 parallel the limitations of 101, 103, and 104 and are rejected in view of the same prior art of record.

21. Claims 137, 139, 141 and 142 the limitations of these claims are directed to the functions of the publisher in an exchange with the user recited in claims 105, 107, 109, 110 and are rejected in view of the same prior art of record.

22. As per claims 121, 123, 125 and 126, the further limitation of adding an edit and transfer history to copyrighted information is disclosed by Daniele and one of ordinary skill in the art would have been motivated to modify the teachings of Dolphin/Atalla with those of Daniele to provide a detail record of the usage in order to allow for proper apportionment of royalties. Claims 121, 123, 125, and 126 are rejected.

23. As per claims 153, 154, and 155, the limitations of a copyright management program is disclosed by Daniele (see Figure 2 and claims). Claims 153-155 are rejected.

24. As per claim 156, the limitation of a plurality of different functions that could be requested by the user and their associated permit keys has been disclosed by Atalla (Column 1, 30-35) Daniele that provides a menu driven selection (see e.g., figure 2) and Dolphin (5:52 – 6:10). Claim 156 is rejected.

25. As per claims 157-168 the limitations the use of a copyright control program, the display of copyright control message, maintaining copyright information and history information on authorship, are disclosed by Daniele (for example see Figure 2 and claims), limiting the number of times digital data may be used, providing the copyright control program with the digital data, a Key control center are disclosed in Dolphin (see e.g. 5:52-6:10; y, lines 25-60). Claims 157-168 rejected.

26. As per claim 169-181, the limitation of a plurality of function, encrypted and supplied by used and providing only the requested function when displayed or edited, display of copyright control message, maintaining copyright information including authorship, usage, is disclosed by Daniele's menu driven copyright control management

Art Unit: 2131

program (see e.g. figure 2, and claims) limitation on the number of times digital data may be used, key control center, and sending algorithm with encrypted digital data are disclosed by Dolphin (see figure 2, 3, 4, and 5:52-6:58). Claims 169-179 are rejected.

Response to Arguments

27. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Seal whose telephone number is 703 308 4562. The examiner can normally be reached on M-F, 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gail Hayes can be reached on 703 305 9711. The fax phone numbers for the organization where this application or proceeding is assigned are 703 746 7239 for regular communications and 703 746 7240 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 3900.

JWS

jws
July 29, 2002

Gail Hayes

GAIL HAYES
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100